

REMARKS

Claims 1-13 are pending in this application. By this Amendment, claims 1 and 3 are amended, claims 11-13 are added and claims 4, 6, 7, 9 and 10 are withdrawn from consideration. Support for the amendments to claims 1 and 3, as well as support for the subject matter of new claims 11-13, can be found at least in Fig. 3 and at page 10, paragraph 3 of the specification. Thus, no new matter is added.

I. Rejection under 35 U.S.C. §112

The Office Action rejects claims 3 and 5 under 35 U.S.C. §112, second paragraph, as being indefinite, alleging that there is insufficient antecedent basis for "the adhesive member." By this amendment, claim 3 is amended responsive to the rejection.

Accordingly, Applicants respectfully request withdrawal of the rejection.

II. Rejections under 35 U.S.C. §102 and §103

The Office Action rejects claims 1-3 under 35 U.S.C. §102(a) as being anticipated by the alleged Applicants' Admitted Prior Art (AAPA); rejects claims 1-3 under 35 U.S.C. §102(a) as being anticipated by JP 2002-126427 ('427); rejects claims 1-3 under 35 U.S.C. §102(a) as being anticipated by JP 2002-126421 ('421); rejects claim 8 under 35 U.S.C. §103(a) as being unpatentable over '421 in view of U.S. Patent No. 5,535,355 (Rowland); rejects claim 8 under 35 U.S.C. §103(a) as being unpatentable over '427 in view of Rowland; rejects claim 8 under 35 U.S.C. §103(a) as being unpatentable over '427 or '421 in view of U.S. Patent No. 5,021,204 (Frost). These rejections are respectfully traversed.

The applied references fail to disclose or render obvious, "a grinding step of grinding an outer peripheral portion of the honeycomb stacked body into a predetermined shape after the masking material separating step," as recited in claim 1.

The Office Action alleges that the present application discloses this feature of claim 1 at page 2, lines 25-30. However, the alleged AAPA does not disclose a grinding step of

grinding an outer peripheral portion of the honeycomb stacked body into a predetermined shape after the masking material separating step, as recited in claim 1. In particular, the AAPA discloses at page 3, lines 9-16 that grinding of the honeycomb stacked body is performed while the masking materials are attached and not after the masking materials have been separated from the honeycomb stacked body, as recited above. Consequently, the AAPA does not disclose the above-quoted feature of independent claim 1.

The Office Action also alleges that '427 discloses all the features of claim 1. However, '427 discloses at paragraph [0035] a method where the masking material is still on a honeycomb structure while the honeycomb is being grinded. Thus, '427 discloses that its masking material is not separated from the honeycomb at the time of grinding. Therefore, '427 fails to disclose grinding an outer peripheral portion of the honeycomb stacked body after the masking material separating step, as recited in independent claim 1.

The Office Action also alleges that '421 discloses all the features of claim 1. In particular, '421 is directed at exfoliation of the adhesion sheet adhered to both end sides of a honeycomb filter. However, '421 fails to disclose any grinding of the honeycomb, and therefore is silent with respect to grinding an outer peripheral portion of the honeycomb stacked body after the masking material separating step, as recited in independent claim 1.

Rowland and Frost fail to at least cure these deficiencies of AAPA, '427 and '421.

Therefore, independent claim 1 is patentable over the applied combination of references. Claims 2, 3, 5 and 8 are patentable at least for their various dependencies from independent claim 1 as well as for the additional features they recite.

Accordingly, Applicant respectfully requests withdrawal of the rejections.

III. New Claims 11-13 Define Patentable Subject Matter


Claims 11-13 are patentable over the applied references. Claims 11-13 are also patentable at least for their various dependencies from the independent claims as well as for the additional features they recite.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims is earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


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